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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,141	05/30/2000	Teruhiko Kori	450100-02564	1297

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FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

ZAND, KAMBIZ

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 12/31/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/580,141

Applicant(s)

KORI ET AL.

Examiner

Kambiz Zand

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,9-24,26-31 and 34-42 is/are rejected.
- 7) ☒ Claim(s) 7,8,25,32 and 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. **Claims 1-42** have been examined.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description Page 11; items "51, 52, 53" with respect to block 5; etc.. Examiner considers items "51, 52, 53" as typo error where 501, 502 and 503 is the correct corresponding number with respect to block 5 of fig.1. Examiner request Correction of all similar errors with respect to specification in a manner that all reference signs mentioned in the description is included in the corresponding drawings.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: "501,502 and 503" in fig. 1; etc... Correction of all similar errors with respect to other drawings is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. **Claims 1-6, 9-24, 26-31 and 34-42** are rejected under 35 U.S.C. 102(e) as being anticipated by Davis et al (6,611,607 B1).

As per claims 1, 4, 11, 16, 21, 23, 27, 30, 36 and 40 Davis et al (6,611,607 B1) teach superimposing information as electronic watermark where the start and end portion of the content is embedded and when copying and recording, it is based on the detection of the superimposed information that contains the start and the end of the content imposed or embedded in the signal and therefore creating a copy management procedures (see abstract; col. 4, lines 14-67; col.5-6, lines 60 where on lines 16-27 of col.6 refers to time of the content that means an start and an ending to the time of the content). Also see entire Davis's content for detailed description of the above limitations.

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As per claims 2-3, 5-6, 9, 10, 12-15, 17-20, 22, 24, 26, 28-29, 31, 34-35, 37-39 and 41-42 Davis et al (6,611,607 B1) teach embedding control information as electronic watermark information where the recording and copying is being done by detection of the superimposed control information on the signal (see col.5, lines 47-67; col.6, lines 1-15); adding identification information to the content information by watermarking and copying by detection of the identification information with respect to the corresponding information such as music (see col.6, lines 5-9 where the owner name may be embedded or col.5, lines 14-27 where the title of the content as an identification of the content may be used for watermarking); and the watermarking of the number of copy count is superimposed by watermarking (see col.6, lines 30-37); and where the updating of the copy control history is recorded (see col.6, lines 30-59); and where the identification information is a piece of music indicated by title (see col.5, lines 14-47).

Allowable Subject Matter

Claims 7, 8, 25, 32 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S. Patent No. US (6,064,737 A) teach anti-piracy system for wireless telephony.

U.S. Patent No. US (6,513,118 B1) teach electronic watermarking method.

U.S. Patent No. US (6,044,182 A) teach method for embedding digital information in an image.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Zand whose telephone number is (703) 306-4169. The examiner can normally be reached on Monday-Thursday (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703) 305-1830. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

Official (703) 872-9306

Kambiz Zand
KZ
12/27/03

AS
ALBERT DEGADY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2108